

Application No. 09/996,315
Amendment dated August 28, 2003
Reply to Office Action of May 1, 2003

REMARKS

Introduction

A one-month extension of time to respond to the May 1, 2003 Office Action is hereby respectfully requested. A check in the amount of \$110.00 is enclosed in payment of the one-month extension-of-time fee.

The specification has been amended to update an outdated cross-reference to another patent application and to correct a minor and obvious typographical error.

Claim 2 has been canceled.

Claims 1 and 3-5 have been amended.

Claims 20-25 have been added.

No new matter has been added by the amendments to the specification and claims.

The restriction of the application to claims 1 and 3-11 has been made final.

Claims 1 and 3-11 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 3 and 5 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent 11-149,673 (hereinafter "Kato").

Claims 4, 10, and 11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kato.

Claims 6-9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kato in view of Taira et al. U.S. Patent 5,809,003 (hereinafter "Taira").

Reconsideration and allowance of this application in light of the following remarks is hereby respectfully requested.

The Rejection Based on 35 U.S.C. § 112

The Examiner rejected claims 1 and 3-11 under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has amended claim 1 in order to more particularly define the invention, and respectfully submits that claim 1, and any claims dependent therefrom, are in compliance with 35 U.S.C. § 112, first paragraph. This rejection is respectfully traversed.

M.P.E.P. § 2164.01 states that "'([t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.'). A patent need not teach, and preferably omits, what is well known in the art," citing In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991).

The Examiner stated that "it is never disclosed . . . exactly how the watermark on the rear of the stamper is transferred to the front of the disk during replication." Office Action, page 2, lines 13-17. Applicant has amended claim 1, so that in the method of forming a "disc using [a] stamper" as defined, "[a] mark on [a] back surface of said stamper is transferred to [a] second surface of said disc, as [an] indelible watermark, in a high pressure molding

process." This "high pressure molding process" is described in the specification at least at page 5, lines 15-22.

Applicant respectfully submits that such a molding (or "replication") process for manufacturing discs was well known to one skilled in the art at the time of filing of the application (see, for example, page 2, line 29 through page 3, line 3, and page 4, lines 2-9). It would have been well understood by one skilled in the art at the time of filing of the present application that, in the same way that the described high pressure molding process causes the pattern of pits and lands on the front surface of the stamper to be transferred to a surface of the disc made of molten material, the same molding process also causes the mark on the back surface of the stamper to be transferred (through the stamper) to the surface of the disc as the indelible watermark.

Beyond the foregoing references to applicant's specification, it states at page 6, lines 10-15 that "[t]hose of ordinary skill in the art may vary the dimensions of markings on the back of a production stamper depending on system parameters, such as the material and thickness of the stamper, the pressure in the mold cavity, and the desired dimensions of the resulting watermark." Thus, applicant respectfully submits that one reasonably skilled in the art could make or use the invention from the disclosures of the present application coupled with information known in the art without undue experimentation, as required by M.P.E.P. § 2164.01. There should be no question that the molding process "at high pressure" as in the specification would support the "transferring . . . in a high pressure molding process" as in applicant's claim 1.

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If there is any doubt, it is well-settled that an invention need not be described in the specification in haec verba in order for the requirements of 35 U.S.C. § 112, first paragraph to be met. The Patent and Trademark Office agrees with applicant on this point. M.P.E.P. § 1302.01, which instructs Examiners to check the specification before allowance to make sure that the claims are described and enabled by the specification, states that there should be "support or antecedent basis in the specification for the terminology used in the claims. . . . It should be noted, however, that exact terms need not be used in haec verba to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112" (emphasis added), citing Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995), which in turn cites other cases:

In order to determine whether a prior application meets the "written description" requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed. [Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555,] 1563, 19 USPQ2d [1111,] 1116; see In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976) ("[L]ack of literal support ... is not enough ... to support a rejection under Section 112.") The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date. Ralston Purina Co. v. Far-Mar-Co., Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). "Precisely how close the original description must come to comply with the description requirement of Section 112 must be determined on a case-by-case basis." Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116.

Similarly, M.P.E.P. § 2163.02, which discusses compliance with the written description requirement, states that "[t]he subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the written description requirement" (emphasis added).

Of similar import is In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983), which states that:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

(Emphasis added; citations omitted.)

According to both Vas-Cath and Kaslow, one must inquire on a case-by-case basis whether or not the specification reasonably conveys to one of ordinary skill in the art that applicant had possession of the claimed invention.*

Applicant believes that it is clear that the specification -- which describes manufacturing discs in a molding process "at high pressure" - reasonably conveys to one of ordinary skill in the art that applicant had possession of the claimed invention of transferring a mark as an indelible watermark "in a high pressure molding process."

* Applicant notes that in Vas-Cath, it was sufficient that the subject matter in question was shown in the drawings, even though it was completely absent from the text. Vas-Cath, 935 F.2d at 1565, 19 USPQ2d at 1118.

Accordingly, applicant respectfully submits that the rejection of claim 1, and claims 3-11 which depend therefrom, under 35 U.S.C. § 112, first paragraph, should be withdrawn.

The Rejection Based on 35 U.S.C. § 102

Applicant's independent claim 1 defines a method of making an information-recording medium having an indelible watermark comprising the steps of providing a mark on a back surface of a stamper and forming a substantially transparent disc using the stamper. The forming step comprises transferring the mark from the back surface of the stamper, as the indelible watermark, to a second surface of the disc, wherein the "indelible watermark is visible under normal light conditions." This claimed feature "uniquely identif[ies] the disc, thereby distinguishing it from any counterfeit disc." Applicant's specification, page 4, lines 15-17.

Nowhere does Kato show or suggest transferring a mark from a surface of a stamper to a surface of a disc, as an indelible watermark, "wherein the indelible watermark is visible under normal light conditions," as recited in applicant's claim 1. Instead, Kato actually teaches away from applicant's claimed invention by providing "a process for producing an information recording carrier capable of identifying watermarks only by the reproduction of disks." Kato, English Translation of (57) Abstract, lines 2-5.

Claim 1 is therefore not anticipated by Kato. Applicant respectfully submits that independent claim 1, and any claims dependent therefrom, are allowable over Kato.

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The Rejections Based on 35 U.S.C. § 103(a)

The Examiner rejected claims 4, 10, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Kato.

The Examiner rejected claims 6-9 under 35 U.S.C. § 103(a) as being unpatentable over Kato in view of Taira.

The Examiner's rejections are respectfully traversed.

Claims 4, 10, and 11

For the same reasons that claim 1 has been shown to be allowable over Kato, claims 4, 10, and 11, which depend from claim 1, are also patentable over Kato.

Claims 6-9

For the same reasons that claim 1 has been shown to be allowable over Kato, claims 6-9, which depend from claim 1, are also patentable over Kato in view of Taira.

Conclusion

The foregoing demonstrates that claims 1 and 3-11, and new claims 20-25 which depend from claim 1, are allowable. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,



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